

## REMARKS

Applicants submit this Response to Office Action in response to the Office Action mailed on August 19, 2010 (non-final). Applicants note with appreciation that the Examiner has objected to claims 15, 16, 18, 19, 28 and 35 as being dependent upon a rejected base claim, but has indicated that such claims are allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Reconsideration is respectfully requested.

### 1. Status of the Claims

Claims 1, 14, 27, 29-31, 34, 38-41, 48, 50-52, 54 and 56 have been rejected. Claims 15, 16, 18, 19, 28 and 35 have been objected to as being dependent upon a rejected base claim, and the Examiner has indicated that these claims would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Claims 1 and 38 are amended herein, claims 2-6, 11, 12, 25, 32, 33, 43-47, 49, 53, 55 and 57 have been withdrawn, and claims 7-10, 13, 17, 20-24, 26-28, 36-37, 42 and 54 have been canceled. No new matter is added by these amendments. After entry of the foregoing amendments, claims 1, 14-16, 18, 19, 29-31, 34, 35, 38-41, 48, 50-52 and 56 are pending in this application.

### 2. Claim Amendments

Applicants have amended independent claim 1 to include all of the limitations of claims 27, 28 and 54. As such, applicants have canceled claims 27, 28 and 54.

Applicants have also amended dependent claim 38. Support for the amendments to claims 1 and 38 can be found in the specification as originally filed.

In view of the foregoing listing of claims, applicants respectfully submit that all pending claims are now in condition for allowance. Reconsideration and withdrawal of the §102 and §103 rejections is respectfully requested.

### 3. Art-Based Rejections

The outstanding Office Action sets forth rejections under 35 USC §102(b) and 35 USC §103(a), as follows:

Claims 1, 14, 29, 30, 31, 50, 52, 54 and 56 are rejected under 35 USC §102(b) as being anticipated by Reyes (USPN 4,205,939) [hereinafter “Reyes”]; and claims 27, 34, 38-41, 48 and 51 are rejected under 35 USC §103(a) as being unpatentable over Reyes.

Applicants respectfully traverse the rejections and submit that the above claims are patentable over Reyes, whether taken alone or in combination with the other art of record. Reconsideration of the foregoing Section 102 and 103 rejections in view of the claim amendments and remarks set forth herein is respectfully requested.

Firstly and with respect to independent claim 1, as amended, applicants note that claim 28 has been objected to as being dependent upon a rejected base claim, and the Examiner has indicated that this claim would be allowable if re-written in independent form including all of the limitations of the base claim (claim 1) and any intervening claims (claims 27 and 54). As noted above, applicants have amended independent claim 1 to include all of the limitations of claims 27, 28 and 54.

For at least the foregoing reasons and in view of the foregoing amendments to independent claim 1, applicants respectfully submit that independent claim 1 is now in condition for allowance. In addition, applicants respectfully submit that dependent claims 14-16, 18, 19, 29, 30, 48 and 50-52, which depend directly or indirectly from independent claim 1, are now in condition for allowance, for at least the reasons noted with respect to independent claim 1.

In regards to independent claim 31, applicants respectfully submit that Reyes fails to anticipate independent claim 31 because Reyes does not describe “each and every element” of applicants’ independent claim 31. According to the MPEP, “[t]o anticipate a claim, the reference must teach every element of the claim.” (See, e.g., MPEP § 2131). “A claim is anticipated only if **each and every** element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicants respectfully submit that independent claim 31 is not anticipated by, nor rendered obvious in view of, Reyes because, *inter alia*, applicants’ claimed unassembled mill relining apparatus includes:

- “a mast that is extendible in length so that it can be locked into a substantially upright position **within a mill;**”
- “a top engagement member connectable or connected to the top end of the mast for engaging **with an upper surface of the mill;**” and
- “a bottom engagement member connectable or connected to the bottom end of the mast for resting **on mill charge within the mill or a lower surface of the mill.**”

Applicants note that Reyes fails to teach or suggest an unassembled mill relining apparatus that includes the noted structures, features and functionalities. Rather, in contrast, Reyes teaches a distinctly different apparatus. More particularly, Reyes relates to an apparatus for remotely repairing tubes **in nuclear steam generators** - not a mill relining apparatus for handling articles within a mill. The operation of inspecting and repairing tubes in a nuclear steam generator is entirely different to the relining of a mill relining apparatus. Applicants’ mill relining apparatus is utilized for replacing worn liners and lifters which are sacrificially disposed against the cylindrical wall of the mill, while Reyes’ apparatus is for inspecting and repairing tubes which are oriented entirely differently **within the channel head of the steam generator**. Furthermore, applicants’ engagement members of the mast engage between a liner (top engagement member) and charge (lower engagement member), rather than two fixed surfaces as in Reyes. In short, Reyes does not teach or disclose an apparatus used to handle/replace liners and lifters within a mill.

Thus, nowhere does Reyes teach or disclose an unassembled mill relining apparatus having, inter alia, “a mast that is extendible in length so that it can be locked into a substantially upright position **within a mill;**” “a top engagement member connectable or connected to the top end of the mast for engaging **with an upper surface of the mill;**” and “a bottom engagement member connectable or connected to the bottom end of the mast for resting **on mill charge within the mill or a lower surface of the mill,**” as recited in applicants’ independent claim 31. In short, Reyes fails to anticipate independent claim 31 because Reyes does not describe “each and every element” of applicants’ independent claim 31.

For at least the foregoing reasons, applicants respectfully submit that independent claim 31, patentably distinguishes over Reyes. In addition, applicants respectfully submit that dependent claims 34, 35, 38 and 56, which depend directly or indirectly from independent claim 31, patentably distinguish over Reyes, whether taken alone or in combination with the other art of record, for at least the reasons noted with respect to independent claim 31.

Turning to independent claim 39, applicants respectfully traverse the §103 rejections. Applicants respectfully submit that independent claim 39 is not anticipated by, nor rendered obvious in view of Reyes because applicants' claimed method of handling articles when relining a mill includes, *inter alia*, the steps of:

- “resting a bottom engagement member of the mast on mill charge within the mill or a lower surface of the mill;”
- “extending the mast so that a top engagement member of the mast engages with an upper surface of the mill to thereby lock the mast in a substantially upright position within the mill;” and
- “operating the article handling arrangement to handle one or more articles within the mill.”

Applicants note that Reyes fails to teach or suggest a method of handling articles when relining a mill that includes these noted steps/limitations/features. For at least the foregoing reasons and the reasons as discussed above with respect to independent claim 31, applicants respectfully submit that independent claim 39, as amended, patentably distinguishes over Reyes, whether taken alone or in combination with the other art of record.

Moreover, applicants respectfully submit that to qualify as an effective reference in a Section 103 obviousness analysis, prior art must be analogous, i.e., categorically related to the claimed invention. *In re Bigio*, 381 F.3d 1320, 72 USPQ 2d 1209 (Fed. Cir. 2004). A reference is *analogous* if it: (a) is in the inventor's specific field of endeavor, or (b) is reasonably pertinent to the problem the inventor is working to solve. *In re GPAC, Inc.* 57 F.3d 1573, 35 USPQ 2d 1116 (Fed. Cir. 1995); see also *Cable Elec. Prod. Inc. v. Genmark*,

*Inc.* 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). If the art used by the Examiner has a purpose which is different from that of the invention, it is not analogous art as an inventor would be less inclined to consider it relevant. *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992).

Against this backdrop, it is noted that Reyes is in the field of inspecting and repairing tubes in a nuclear steam generator, which is an industry that is entirely distinct from the field of handling articles when relining a mill. As noted above, the operation of inspecting and repairing tubes in a nuclear steam generator is entirely different to the relining of a mill relining method and/or apparatus. Applicants' mill relining method/apparatus is utilized for replacing worn liners and lifters which are sacrificially disposed against the cylindrical wall of the mill, while Reyes' apparatus is for inspecting and repairing tubes which are oriented entirely differently **within the channel head of the steam generator**. Furthermore, applicants' engagement members of the mast engage between a liner (top engagement member) and charge (lower engagement member), rather than two fixed surfaces as in Reyes. Accordingly, applicants respectfully traverse the 103(a) rejections based on the Reyes; Reyes is not analogous art, and is not citable.

For at least the foregoing reasons and the reasons as discussed above with respect to independent claim 31, applicants respectfully submit that independent claim 39, as amended, patentably distinguishes over Reyes, whether taken alone or in combination with the other art of record. In addition, applicants respectfully submit that dependent claims 40 and 41, which depend directly or indirectly from independent claim 39, patentably distinguish over Reyes, whether taken alone or in combination with the other art of record, for at least the reasons noted with respect to independent claim 39.


### **CONCLUSION**

In view of the above-mentioned claim amendments and remarks, it is respectfully submitted that claims 1, 14-16, 18, 19, 29-31, 34, 35, 38-41, 48, 50-52 and 56 are now in condition for allowance.

Early and favorable action is earnestly solicited. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

Date: December 20, 2010

  
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Aaron P. Bumgarner  
Reg. No. 53,860  
Attorney for Applicants

McCARTER & ENGLISH, LLP  
One Canterbury Green  
201 Broad Street  
Stamford, CT 06901  
(203) 399-5946  
(203) 399-5846 (fax)